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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/738,023	12/15/2000	Bryan Blair	1-Step Surety System	9285
45722	7590	03/13/2008		
Howard IP Law Group P.O. Box 226 Fort Washington, PA 19034			EXAMINER FRENEL, VANEL	
			ART UNIT 3687	PAPER NUMBER
			MAIL DATE 03/13/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/738,023	<b>Applicant(s)</b> BLAIR ET AL.	
	<b>Examiner</b> VANEL FRENEL	<b>Art Unit</b> 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,18 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-6, 18 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### **Notice to Applicant**

1. This communication is in response to the Appeal Brief filed on 9/28/07. Claims 1, 3-6, 18 and 21 are pending.

2. In view of the Appeal Brief filed on 01/20/06, PROSECUTION IS HEREBY REOPENED as set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 C.F.R 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplement appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193) (b)(2).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1, 3-6, 18 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luchs et al (4,831,526) in view of Bosco (5,191,522) in further in view of Sforzo (7,194,435).

(A) As per claim 1, Luchs discloses storing underwriting data so as to be accessible by at least one computer processor (See Luchs, Col.1, lines 63-68 to Col.2, line 18; Col.6, lines 13-68); wherein data indicative of said insurance underwriting instrument is automatically stored so as to be accessible to said one computer processor (See Luchs, Col.1, lines 63-68 to Col.2, line 18; Col.6, lines 13-68).

Luchs does not explicitly disclose calculated premium in response to a request therefore.

However, this feature is known in the art, as evidenced Bosco. In particular, Bosco suggests calculated premium in response to a request therefore (See Bosco, Col.26, lines 63-68 to Col.27, line 52).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Bosco within the system of Luchs with the motivation of providing a fully integrated information storage, processing and reporting system which will function as a single repository for sales, underwriting, actuarial and management information (See Bosco, Col.2, lines 5-25).

In addition, as best understood, Luchs and Bosco disclose all the limitations above. The combination of Luchs and Bosco do not explicitly disclose a computer method for issuing at least one of a fidelity bond and a surety bond comprising: storing data indicative of at least one of fidelity and surety bond customers so as to be

accessible by said at least one computer processor; inputting data indicative of at least one fidelity or surety bond to be issued and being associated with one of said bond customers; automatically calculating of images a premium for the at least one fidelity or surety bond to be issued based on the input data and the underwriting data in response to a request therefore; storing data indicative of images of a plurality of pre-defined bond forms so as to be accessible by said at least one computer processor; selecting a sub-set of the data indicative of images of a plurality of pre-defined bond forms dependently upon the inputted data; and automatically rendering the at least one fidelity or surety bond to be issued using said data indicative of said selected data indicative of images of a plurality of pre-defined forms.

However, these features are known in the art, as evidenced by Sforzo. In particular, Sforzo suggests a computer method for issuing at least one of a fidelity bond and a surety bond (See Sforzo, Fig.14; Col.2, lines 50-67) comprising: storing data indicative of at least one of fidelity and surety bond customers so as to be accessible by said at least one computer processor (See Sforzo, Col.6, lines 34-55); inputting data indicative of at least one fidelity or surety bond to be issued and being associated with one of said bond customers (See Sforzo, Col.7, lines 55-67 to Col.8, line 14); automatically calculating of images a premium for the at least one fidelity or surety bond to be issued based on the input data and the underwriting data in response to a request therefore (See Sforzo, Col.5, lines 27-67 to Col.6, line 34); storing data indicative of images of a plurality of pre-defined bond forms so as to be accessible by said at least one computer processor (See Sforzo, Col.6, lines 34-55); selecting a sub-set of the data

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indicative of images of a plurality of pre-defined bond forms dependently upon the inputted data (See Sforzo, Col.7, lines 46-67 to Col.8, line 16); and automatically rendering the at least one fidelity or surety bond to be issued using said data indicative of said selected data indicative of images of a plurality of pre-defined forms (See Sforzo, Col.9, lines 6-67; Col.11, lines 14-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Sforzo within the collective teachings of Luchs and Bosco with the motivation of computerizing systems and more particularly to a computerized system for automated issuances of bonds through a communications linkage for communicating and processing information necessary for the issuance of a bond in a timely and efficient manner (See Sforzo, Col.2, lines 60-64).

(B) As per claim 3, Luchs discloses the method wherein said inputting comprises presenting at least one electronic document to a user via a browser functionality of software running on a microprocessor based device, and communicating data input to said software by said user to said at least one processor (Col.1, lines 63-68 to Col.2, line 18; Col.6, lines 13-68).

(C) As per claim 4, Luchs discloses the method further comprising automatically calculating a premium for at least one alternative insurance underwriting instrument having at least one characteristic differing from said insurance underwriting instrument

(Col.11, lines 3-47; Col.13, lines 3-63).

(D) As per claim 5, Luchs discloses the method further comprising automatically storing said input data (Col.11, lines 3-33).

(E) As per claim 6, Luchs discloses the method further comprising: providing data indicative of images of a plurality of insurance underwriting instruments (Col. 13, lines 30-68); wherein said rendering comprises selecting one of said instruments dependently upon said input data (Col.13, lines 30-68 to Col.14, line 36); and, uses at least a portion of said data indicative of images of said plurality of underwriting instruments being associated with said selected one of said instruments (Col. 19, lines 22-68 to Col.20, line 68).

(F) As per claim 18, Lucks discloses a first query-able plurality of memory locations for storing data indicative of images of a plurality of forms (See Luchs, Col.14, lines 46-68), a second query-able plurality of memory locations storing data indicative of policies (Col.13, lines 3-68 to Col.14, line 68).

Lucks does not explicitly disclose at least one calculator application responsive to said user interface and for automatically calculating a premium for the insurance underwriting instrument based on the input data using said at least one computer processor.

However, this feature is known in the art, as evidenced by Bosco. In particular, Bosco suggests at least one calculator application responsive to said user interface and for automatically calculating a premium for the insurance underwriting instrument based on the input data using said at least one computer processor (See Bosco, Col.26, lines 63-68 to Col.27, line 52).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Bosco within the system of Luchs with the motivation of providing a fully integrated information storage, processing and reporting system which will function as a single repository for sales, underwriting, actuarial and management information (See Bosco, Col.2, lines 5-25).

In addition, as best understood, Luchs and Bosco teach all the limitations above. The combination of Luchs and Bosco do not explicitly disclose a data processing system for issuing a fidelity or surety bond, the system comprising: at least one computer processor; each of said forms being associated with a particular type of fidelity or surety bond; at least one user interface for inputting data indicative of an insurance client and data indicative of the fidelity or surety bond, data indicative of one of the fidelity or surety bond; and software for rendering selected ones of said plurality of forms using said data stored in said first and second pluralities of memory locations and calculated premium in response to a request from said user interface.

However, these features are known in the art, as evidenced by Sforzo. In particular, Sforzo suggests that a data processing system for issuing a fidelity or surety bond, the system comprising: at least one computer processor (See Sforzo, Col.6, lines



34-45); each of said forms being associated with a particular type of fidelity or surety bond (See Sforzo, Fig.14; Col.2, lines 50-67); at least one user interface for inputting data indicative of an insurance client and data indicative of the fidelity or surety bond, data indicative of one of the fidelity or surety bond (See Sforzo, Fig.14; Col.2, lines 50-67); and software for rendering selected ones of said plurality of forms using said data stored in said first and second pluralities of memory locations and calculated premium in response to a request from said user interface (See Sforzo, Fig.1B; Col.6, lines 12-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Sforzo within the collective teachings of Luchs and Bosco with the motivation of computerizing systems and more particularly to a computerized system for automated issuances of bonds through a communications linkage for communicating and processing information necessary for the issuance of a bond in a timely and efficient manner (See Sforzo, Col.2, lines 60-64).

(G) As per claim 21, Luchs discloses identifying data stored in a plurality of memory locations and being indicative of a select one of a plurality of customers (Co1.13, lines 3-68 to Co1.14, line 68); selecting at least one of a plurality of forms for said insurance instrument (See Luchs, Col. 4, lines 27-47).

Luchs does not explicitly disclose wherein, said calculating and rendering are performed using said at least one computing processor.

However, this feature is known in the art, as evidenced by Bosco. In particular, Bosco suggests wherein, said calculating and rendering are performed using said at least one computing processor (See Bosco, Col.26, lines 63-68 to Col.27, line 52).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Bosco within the system of Luchs with the motivation of providing a fully integrated information storage, processing and reporting system which will function as a single repository for sales, underwriting, actuarial and management information (See Bosco, Col.2, lines 5-25).

In addition, as best understood, Luchs and Bosco teach all the limitations above. The combination of Luchs and Bosco do not explicitly disclose a method for issuing an fidelity or surety bond comprising: receiving data indicative of a fidelity or surety bond to be associated with said select customer; automatically calculating at least one rate associated with said fidelity or surety bond using said data indicative of said customer and data indicative of said fidelity or surety bond to be associated with said select customer; using said data indicative of said fidelity or surety bond to be associated with said select customer; and automatically rendering said at least one form using said at least one rate, said data indicative of said customer, and data indicative of said fidelity or surety bond to be associated with said select customer.

However, these features are known in the art, as evidenced by Sforzo. In particular, Sforzo suggests a method for issuing an fidelity or surety bond comprising: receiving data indicative of a fidelity or surety bond to be associated with said select customer (See Sforzo, Col.7, lines 55-67 to Col.8, line 14); automatically calculating at

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least one rate associated with said fidelity or surety bond using said data indicative of said customer and data indicative of said fidelity or surety bond to be associated with said select customer (See Sforzo, Col.7, lines 55-67 to Col.8, line 14); using said data indicative of said fidelity or surety bond to be associated with said select customer (See Sforzo, Col.7, lines 55-67 to Col.8, line 14); and automatically rendering said at least one form using said at least one rate, said data indicative of said customer, and data indicative of said fidelity or surety bond to be associated with said select customer (See Sforzo, Col.11, lines 1-65).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Sforzo within the collective teachings of Luchs and Bosco with the motivation of computerizing systems and more particularly to a computerized system for automated issuances of bonds through a communications linkage for communicating and processing information necessary for the issuance of a bond in a timely and efficient manner (See Sforzo, Col.2, lines 60-64).

### ***Response to Arguments***

5. Applicant's arguments filed on 9/28/07 with respect to claims 1, 3-6, 18 and 21 have been fully considered but they are not persuasive.

(A) At pages 14-22 of the response filed on 9/28/07, Applicant's argues the followings:

(i) The Office Action fails to provide any reason for combining the Luchs, Bosco and Sforzo references.

(B) In response, Examiner respectfully thanked Applicant's comments by stating that there is no motivation to combine Luchs, Bosco and Sforzo references. However, the Examiner mentioned that He had already provided the motivation for combining in the rejection of the Office Action mailed on 4/03/07. Since Applicant's has amended the claimed a second time, Examiner has brought Sforzo reference which discloses computerized method, apparatus and system for issuing surety bonds and the made the Office Action Final on 4/03/07. Therefore, Examiner has been clarifying His point of view regarding the issues that Applicant's has been requesting in the Appeal Brief and since Applicant's arguments are not persuasive, the Office Action is hereby made Final.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 571-272-6769. The examiner can normally be reached on 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zeender Ryan Florian can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vanel Frenel/  
Examiner, Art Unit 3627

February 26, 2008